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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,292	03/27/2001	Daniel F. Williams	PSTM0042/MRK	1726
29524 7590 11/15/2007 KHORSANDI PATENT LAW GROUP, A.L.C. 140 S. LAKE., SUITE 312 PASADENA, CA 91101-4710			EXAMINER PLUCINSKI, JAMISUE A	
			ART UNIT 3629	PAPER NUMBER
			MAIL DATE 11/15/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/820,292

Applicant(s)

WILLIAMS ET AL.

Examiner

Jamisque A. Plucinski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-169 is/are pending in the application.
- 4a) Of the above claim(s) 22-26, 28-61, 66-99, 104-137 and 142-169 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21, 27, 62-65, 100-103 and 138-141 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 20070808
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1-10, 19-21, 60-65, and 100-102 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwab et al. (US 2002/0019777) in view of Siegel (US 2004/01435519) and Junger (6,269,344).
3. With respect to Claims 1-9, 60-65, and 100-102: Schwab discloses the use of an online merchandise return computer system (see abstract, the examiner considers the online merchandise return computer system to include both the merchant computer, as well as the third

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party/agent computer, due to the fact that they both computers cooperatively work together, to process and return a product) where the computer system is programmed to:

- a. Receive an indication of shipment of an item and a indication that the item is returnable (see ReturnCert, and Paragraph 0052-0053).
 - b. Save a set of return rules which is inputted by a merchant (Paragraphs 0052 and 0053) where the rules provides exceptions where a user cannot return item (Paragraph 0071)
 - c. Receive an online return request by a consumer (Paragraph 0052);
 - d. Process return request according to the set of return rules (Paragraph 0053).
 - e. Schwab discloses the use of a set or return questions (Parameter request, reference numeral 605, product return parameters, such as description of product and condition of product), and processing the return according to the rules (See Paragraphs 0012, and Paragraph 0053).
4. Schwab, however, fails to disclose the use of a display, which displays each item of a previous order and an interactive means associated with each item in each order, to return an item. Siegel discloses a return system where a user's previous orders along with each item in the order are displayed, and each item is associated with a checkbox, which the examiner considers to be an interactive means, to submit a return request (See Figure 1A with corresponding detailed description). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Schwab to include the display and interactive means of Siegel, in order to provide a single action return process to reduce the amount of sensitive information transmitted to increase security and ease of use for the customer (See Siegel, Pages 1 and 2).

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5. Schwab and Siegal disclose the use of a method for authorizing returns, however Schwab and Siegal disclose the initiation of the return being through a third party website, and fails to disclose it being through the online retail computer system. Junger discloses the use of a return system at a local site, then this information is sent to a remote approval computer system for authorization of the return (Column 2, lines 46-67). Therefore, with the return processing method of Schwab and Siegal, disclosing the claim limitations of Claim 1. Because both Schwab and Siegal and Junger teach methods for returning purchased items, it would have been obvious to one skilled in the art to substitute one method for the other to achieve the predictable result of returning an item to a retailer. (See *KSR International Co. v. Teleflex Inc.*, 550 US-82 USPQ2d 1385 (2007))

6. With respect to Claims 19 and 20: Siegel discloses the use of an online merchandise return system, which prints shipping labels for returns (See abstract).

7. With respect to Claim 21: See Siegel, Figure 1A, and Figure 5 with corresponding detailed descriptions

8. Claims 10-12, 27, 62-65, 103, and 138-141 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwab et al., Siegel and Junger and further in view of Kara (6,233,568).

9. With respect to Claims 10, 11, 24, 25, 62-64 and 138-141: Schwab, as disclosed above for Claims 1, 39, 11 and 115, disclose the use of shipping the return to the manufacturer, but fails to disclose selecting a carrier for shipment and calculating the shipping rate for the return. Kara discloses the use of a system used to select a carrier for shipment and calculating shipping rates for a plurality of carriers (See Figure 8, with corresponding detailed description). It would have

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been obvious to one having ordinary skill in the art at the time the invention was made to modify Schwab, to include the ability to select a carrier and calculate the shipping rates for the carriers, according to Kara, in order to for the user to make an informed choice as to the most preferable method of shipment. (See Kara, abstract).

10. With respect to Claims 12, 27, 65, and 103: See Kara Figure 8.

11. Claims 13-21, 27, and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwab, Siegel, Junger and Kara as applied to claim 11 above, and further in view of UPS® Service Guide (www.ups.com) and FedEx® Services (www.fedex.com) and Barnett et al. (6,369,840).

12. With respect to Claims 13-16, 27, and 65: Schwab and Kara discloses an onscreen interactive display with a selection and comparison section for a plurality of carriers with a plurality of services (See Kara, Figure 8). However Kara does not specifically disclose the rates being calculated with respect to time. Both UPS® and FedEx® disclose specific services where they are guaranteed delivery by a certain time in the day. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include the time sensitive “urgency” services, as disclosed by FedEx® and UPS®, in order to ship thing and compete with a time advantage using guaranteed delivery times and to reduce costs, when delivery time is not of importance. (See Fed Ex Page 1). Kara, UPS® and FedEx® fail to disclose the use of a graph which simultaneously displays a graph of shipping fees and services, where one axis being date and one axis being time and where each cell is located at the intersection of the date and time. Barnet discloses the use of a calendar which can be sued for online purchasing of services

(column 2, lines 63-67), where there is a graphical representation of date on one axis and time on another (See Figure 9). It would have been obvious to one having ordinary skill in the art at the time the invention was made to display the calculation of shipping rates, calculated by Kara, UPS® and FedEx®, in the format of a plurality of cells with date on one axis and time on another, as disclosed by Barnett, in order to provide a multi-layers system wherein different categories can be overlaid on one another providing a single integrated display that allows a user to order or purchase a system based on the calendar day and time (See Barnett, column 2).

13. With respect to Claim 17: See Schwab, return transaction 619.

14. With respect to Claim 18: See Kara, Figure 9.

Response to Arguments

15. Applicant's arguments filed 8/8/07 have been fully considered but they are not persuasive.

16. With respect to Applicant's arguments in terms of the subject matter of claim 1 of "through an online retail computer system", this argument is considered to be moot in view of the new rejection applied above.

17. With respect to Applicant's argument in terms of the combination of Schwab and Siegel and the references teaching away from each other: The applicant has stated that Siegel is used to reduce the amount of sensitive information transmitted, and the return cert of Schwab transmits sensitive data, therefore teaching away from Siegel. Even though the return cert of Schwab may contain sensitive information, it does not have to be inputted by the customer, it is already known. And even though the returnCert may contain sensitive information, it is not in the form

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of human readable information, but rather encrypted, so therefore still used to protect the user for increased security. Therefore the examiner does not consider Schwab and Siegel to teach away from each other.

18. In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning: it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. In re McLaughlin, 443 F.2d 1392; 170 USPQ 209 (CCPA 1971) The examiner has only relied upon the disclosure of the prior art to show the claimed invention, therefore the examiner does not consider the rejection to be based only on hindsight reasoning, and therefore rejection stands as stated above.

19. With respect to Applicant's argument that Siegel's returns are based on purchased item, not on shipped items: No matter what the items are called, they are returned, so whether the items were first purchased or shipped, this was done outside of the system and method as claimed, and terms "shipped" or "purchased" are simply descriptive non-functional limitations used to describe what type of items are being used.

20. With respect to Applicant's argument that Siegel, Schwab and Kara do not disclose the merchant inputting a set of return policy rules and selection of appropriate carriers: where as one of these references may not disclose this limitation alone, the combination of references do. Schwab discloses inputting return rules and Kara discloses merchants entering appropriate carriers, therefore the combination of references disclose this rejection.

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21. With respect to Applicant's argument that Claim 110 is patentably distinct from the references of record: It should be noted that a graphic user interface is simply an interface which is used to input information. There is nothing specific in the claims, besides a graphic user interface (which can be as simple as a word document), this is considered to be a general term. Therefore if the rules are inputted into a computer, then it is done through a graphic user interface. The prior art of record does this, therefore this limitation is considered to be disclosed, as described above. Furthermore, it should be noted, that the claims are directed to the computer system and method for returning an item. If the applicant amends this claim too much so claim the specifics of the user interface as well as the system behind it, which is specific for one side of the process, the examiner at that time may require a restriction.

22. Arguments are not considered to be persuasive and the Rejections stand as stated above.

Conclusion

23. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

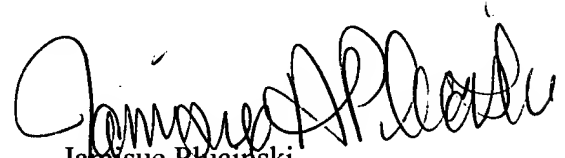
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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Plucinski whose telephone number is (571) 272-6811. The examiner can normally be reached on M-Th (5:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Jamisue Plucinski
Primary Examiner
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